

REMARKS

The Office Action mailed June 28, 2005, has been received and reviewed. Claims 1, 3-10, and 14-16 are pending in the application. Claims 2 and 11-13 stand canceled. Claims 1, 3-10, and 14-16 stand rejected. The application is to be amended as previously set forth without prejudice or disclaimer. All amendments are made without prejudice or disclaimer. No new matter has been added. Reconsideration is respectfully requested.

Sequence requirements

The specification stands objected to as allegedly not complying with the sequence listing rules. Applicants are submitting a substitute sequence listing and Replacement sheets for Figures 2a-2b, 6-7, and 9. No new matter has been added.

Figures

Applicants are submitting replacement sheets for Figures 2a, 2b, 6, 7, and 9. No new matter was added. The only alteration made to the Figures was the addition of SEQ ID NOs.

Specification

The specification stands objected to allegedly for a typographical error. Applicants have amended the first paragraph on page 31 of the specification. Applicants respectfully request reconsideration.

Section 112 rejections

Claims 1, 2-10, and 14-16 stand rejected under 35 USC §112, 1st ¶ as allegedly failing to comply with the written description requirement. The Examiner alleges that Applicants have not provided a disclosure of the insertion of two redundant stop codons. Applicants respectfully request reconsideration in light of the specific examples listed by the Examiner and the language in the specification on page 7, third paragraph, wherein it states:

Also encompassed within this invention is an EIAV wherein said virus contains a mutation of the *S2* gene or portions thereof ($\Delta S2$), a mutation in the *DU* gene (ΔDU) or a portion thereof, a mutation in a regulatory gene that inhibits expression of the *S2* or *DU* genes or a combination of types of said mutations ($\Delta S2\Delta DU$). It

is expected that further mutations can be made such that the EIAV in the vaccine contains multiple mutations in multiple genes including the $\Delta S2$, ΔDU or both.

Accordingly, Applicants clearly intended for multiple mutations to be included within the scope of the claims. The Examiner already illustrated a specific insertion of a stop codon. As an insertion of a stop codon is a mutation, and the specification discloses multiple mutations, multiple insertions of stop codons have been disclosed.

It has long been the law that a proper test for the written description requirement is whether the description clearly allows persons of ordinary skill in the art to recognize that the inventors invented what is claimed. See MPEP 2163.02 and *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed.Cir. 1989). Here, an insertion of a stop codon is given in the examples. Here, multiple mutations are clearly described. Accordingly, there is no question that the inventors invented what is claimed.

Rejections under 35 USC §102

Claims 1, 3, 4, and 16 stand rejected under 36 USC §102(b) as allegedly being anticipated by Li(A). Applicants have filed the Declaration of Dr. Montelaro as proof that the Li(A) publication is a publication of various aspects of Applicants' invention. See Declaration of Dr. Montelaro, ¶¶3-6. All of the authors of the Li(A) article were participants in the described research project in Dr. Montelaro's laboratory for which he was the principal investigator providing direction and supervision for all project activities. See Declaration of Dr. Montelaro, ¶¶3,4. The authors of the Li(A) article are Feng Li, Bridget A. Puffer, and Ronald Montelaro. See Declaration of Dr. Montelaro, ¶¶3-4.

Dr. Montelaro has declared that Feng Li and Bridget A. Puffer worked under his direction and supervision. See Declaration of Dr. Montelaro, ¶¶3-6. Accordingly the Li(A) article is not available as prior art. *See* MPEP 715.01(c) and *In re Katz*, 687 F.2d 450 (CCPA 1982).

Claim 21 stands rejected under 35 USC §102(a) as allegedly being anticipated by Li(B). Applicants have filed the Declaration of Dr. Montelaro as proof that the Li(B) publication is a publication of various aspects of Applicants' invention. See Declaration of Dr. Montelaro, ¶¶3 and 7-9. All of the authors of the Li(A) article were participants in the described research project

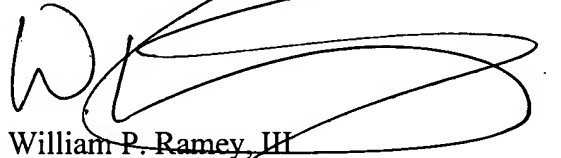
in his laboratory for which he was the principal investigator providing direction and supervision for all project activities. See Declaration of Dr. Montelaro, ¶¶3,7. The authors of the Li(A) article are Feng Li, Bridget A. Puffer (hereinafter collectively referred to as the "others"), and Ronald Montelaro. See Declaration of Dr. Montelaro, ¶¶3, 7.

Dr. Montelaro has declared that the "others" alleged by the Examiner worked under his direction and supervision. See Declaration of Dr. Montelaro, ¶¶3, 7-9. Accordingly, the Li(B) article is not available as prior art. *See* MPEP 715.01(c) **and** *In re Katz, supra*.

CONCLUSION

Applicants respectfully request reconsideration of the rejections. Applicants invite the Examiner to contact the undersigned attorney to facilitate allowance of the case.

Respectfully submitted,



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